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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,459	08/03/2001	G. Herbert Lin	M142.12-0017	1375

27365 7590 09/29/2009  
SEAGATE TECHNOLOGY LLC  
C/O WESTMAN, CHAMPLIN & KELLY, P.A.  
SUITE 1400  
900 SECOND AVENUE SOUTH  
MINNEAPOLIS, MN 55402-3244

EXAMINER
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MERCEDES, DISMERY E

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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09/29/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* G. HERBERT LIN, DAVID GUARISCO, and XIAOKUN CHEW

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Appeal 2009-000729<sup>1</sup>  
Application 09/922,459  
Technology Center 2600

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Decided: September 29, 2009

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Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and  
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application claims benefit of U.S. Provisional Application 60/233,444  
filed August 4, 2000.

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-100. *See* App. Br. 5. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

### STATEMENT OF THE CASE

Appellants invented a method and device for providing early warning of thermal decay within a magnetic disk by incorporating a test pattern having a different data density than the user data on the disk.<sup>2</sup>

Claim 1, which further illustrates the invention, follows:

1. A method for providing an early warning of thermal decay, comprising: writing a test pattern to a track of a magnetic disk, wherein said test pattern has a higher data density than a data density of user data in said track; measuring an amplitude of a signal produced by reading said test pattern; storing said measured amplitude; reading said test pattern from said track to obtain an observed amplitude of a signal produced by said test pattern; comparing said measured amplitude to said observed amplitude; and producing a thermal decay warning signal if said comparison is unfavorable.

### *The Rejections*<sup>3</sup>

The Examiner relies upon the following prior art references as evidence of unpatentability:

Emo	US 6,091,559	Jul. 18, 2000
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<sup>2</sup> *See generally* App. Br. 5-7.

<sup>3</sup> Examiner withdrew the obviousness rejection of claims 9, 19, 36, 62-64, 67-69, 72-74, 77, 81, 86, and 91 (Ans. 15).

Alex	US 6,429,984 B1	Aug. 6, 2002 (filed Aug. 6, 1999)
Quak	US 6,633,442 B2	Oct. 14, 2003 (filed Aug. 4, 2000)

Claims 1-100 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement (Ans. 3-7).

Claims 1, 2, 4, 6-8, 10, 11, 14, 16-18, 47-52, 61, 66, 71, and 76 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Alex and Quak (Ans. 7-12).

Claims 3, 65, 70, and 75 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Alex, Quak, and Emo (Ans. 13).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

*35 U.S.C. § 112, first paragraph, enablement requirement*

Claims 1-100 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement because the claims contain subject matter that was not described in the Specification (Ans. 3). The Examiner indicates that claim limitations from independent claims 1, 11, 21, 36, 47, 56, 61, 66, 71, 76, 81, 91, and 96 are not enabled by the Specification because they were not mentioned or described in the Provisional Application (Ans. 3-7). Appellants argue that the Examiner did not indicate that the claims were unsupported by the Specification (App. Br.

12). It is Appellants' position that the Examiner has confused domestic priority, which involves the Provisional Application, with the enablement requirement, which does not involve the Provisional Application. *Id.*

## ISSUE

Have Appellants shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, because the Provisional Application fails to describe or mention limitations that are present in the claims?

## PRINCIPLES OF LAW

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988) (citation omitted).

“[A] patent disclosure need not enable information within the knowledge of an ordinarily skilled artisan. Thus, a patentee preferably omits from the disclosure any routine technology that is well known at the time of application.” *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004) (citation omitted).

## ANALYSIS

Appellants argue that the Examiner only asserts that the *Provisional Application is silent in mentioning and/or describing* the claimed invention, and therefore the Examiner has failed to provide evidence that the

Specification fails to enable the claimed invention (App. Br. 12). We find Appellants' arguments persuasive. The Examiner argues that the claims are not enabled because the Provisional Application fails to mention *how to make or use the entire procedure claimed* (Ans. 14-15) ; however, the test for enablement is based upon the content of the disclosure (i.e., the utility application), not the Provisional Application relied upon to establish domestic priority. *See Telectronics*, 857 F.2d at 785; *see also Chiron*, 363 F.3d at 1254. Since the Examiner did not address the enablement of the claims in regard to the instant application's Specification or disclosure, we find that Appellants' arguments are persuasive, and therefore we will not sustain the Examiner's enablement rejection of claims 1-100.

### *Obviousness Rejections*

Claims not addressed by the Examiner's obviousness rejections.

1. The Examiner withdrew the obviousness rejection of claims 9, 19, 36, 62-64, 67-69, 72-74, 77, 81, 86, and 91 (Ans. 15).

2. The Examiner objected to claims 5, 13, 44-46, 53-55, 64, 69, 74, and 78-80.

3. In addition, the Examiner did not address the following claims within the obviousness rejections:

- dependent claims 12 and 20, which are dependent upon independent claim 11;
- dependent claim 15, which is dependent upon claim 14, which is dependent upon independent claim 11;
- independent claim 21 and dependent claims 22-29, which are dependent upon claim 21;

- independent claim 30 and dependent claims 31-35, which are dependent upon claim 30;
- dependent claims 37-43, which are dependent upon independent claim 36 (whose rejection was withdrawn by the Examiner);
- independent claim 56 and dependent claims 57-60, which are dependent upon claim 56;
- dependent claims 82-85, which are dependent upon independent claim 81 (whose rejection was withdrawn by the Examiner);
- dependent claims 87-90, which are dependent upon independent claim 86 (whose rejection was withdrawn by the Examiner);
- dependent claims 92-95, which are dependent upon independent claim 91 (whose rejection was withdrawn by the Examiner);
- independent claim 96 and dependent claims 97-100, which are dependent upon claim 96.

We did not sustain the Examiner's enablement rejection of claims 1-100 and the Examiner did not address all of the claims in the application within the obviousness rejections of record, as noted above; the resultant status of these claims still must be determined. We will defer determining the status of these claims until the issues pertaining to the obviousness rejections are resolved.

Claims addressed by the Examiner's obviousness rejections.

Appellants argue that Quak is not prior art to claim 61 because Quak claims priority from a Provisional Application that was filed on August 4, 2000, the same day as Appellants' effective filing date for the instant application (App. Br. 17). The Examiner argues that Quak qualifies as prior

art because the Provisional Application that Appellants rely upon to establish the August 4, 2000, effective filing date fails to meet the enablement requirement under 35 U.S.C. § 112, first paragraph. Although we did not sustain the Examiner's enablement rejection, we still have the matter of determining if Quak qualifies as prior art.

### ISSUES

Does Quak qualify as prior art under 35 U.S.C. § 102(e)?

If Quak does qualify as prior art, have Appellants shown that the Examiner erred in finding that the combination of Alex and Quak discloses a method for providing an early warning of thermal decay on a magnetic disk wherein a test pattern has a higher data density than the user data on the disk?

If Quak does qualify as prior art, have Appellants shown that the Examiner erred in finding that the combination of Alex, Quak, and Emo discloses a track located in a first zone and a frequency for the user data located in a second zone of a magnetic disk?

### FINDINGS OF FACT

1. Appellants filed the instant application 09/922,459 on August 3, 2001.
2. Appellants claimed priority under 35 U.S.C. § 119(e) to Provisional Application 60/223,444, so the effective filing date of the application became the same as the filing date of the Provisional Application, which is August 4, 2000.



3. Quak (US 6,633,442) has an effective filing date of August 4, 2000, by claiming priority to Provisional Application 60/222,995.

### PRINCIPLES OF LAW

Validity of domestic priority of an application based upon a Provisional Application must be confirmed by determining that the Provisional Application supports the claimed subject matter under § 112. *See Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential); *see also Ex parte Sextro*, No. 2008-4355, 2008 WL 5168080, at \*4 (BPAI Dec. 9, 2008).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). If the Examiner's burden is met, the burden then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

### ANALYSIS

Appellants are relying upon a Provisional Application to establish an effective filing date of August 4, 2000 (FF 1-2). The Examiner states that

independent claims 1, 11, 47, 61, 66, 71, and 76 all have limitations that are not supported by the Provisional Application (Ans. 3-7). (Although the Examiner indicated more claims than are listed above, we are only addressing those claims that are rejected under obviousness.) The Examiner rejects the claims under two obviousness rejections, with both of the rejections relying upon the Quak reference, as we noted previously. The effective filing date of Quak is August 4, 2000 (FF 3), the *same day* that Appellants' provisional application was filed (FF 2). Therefore, if we determine that Appellants are entitled to the benefit of their provisional application filing date regarding the disputed limitations, then Quak would not qualify as prior art under § 102(e) for those limitations since it would not be effectively filed *before* Appellants' effective filing date (i.e., the provisional application filing date).

On the other hand, if we determine that Appellants are not entitled to the filing date of the Provisional Application, the application's effective filing date would be August 3, 2001. *See Sextro*, 2008 WL 5168080 at \*4; *see also* FF 1. In that event, Quak would qualify as prior art under 35 U.S.C. § 102(e), and would therefore have to be evaluated on the merits of its disclosure in regard to the obviousness rejections. *See Oetiker*, 977 F.2d at 1445.

The Examiner argues that the Provisional only provides support for writing a frequency of one zone into a different zone and does not establish support for the limitation of writing a test pattern into a track wherein the test pattern has a higher data density of user data in said track (App. Br. 14). Referring to claim 1, Appellants rely upon a chart to show where the support for the claim limitation is located in the Provisional (App. Br. 33-34). Thus,

we do not find the Examiner's arguments persuasive. We do not disagree with the Examiner's assessment that the Provisional discloses writing a frequency for one zone into another zone; however, just because the Provisional does not specifically indicate writing into a track does not mean that it does not. Appellants can omit basic technology that is well known at the time of the application without compromising the enablement of the disclosure. *See Chiron*, 363 F.3d at 1254. Writing data into tracks where it can be accessed and read by heads is one of the basic concepts of a magnetic disk.

The Examiner indicated that independent claims 11, 47, 61, 66, 71, and 76 also have limitations that are not supported by the Provisional Application, but fails to address Appellants' arguments (Ans. 14-15). *See also* App. Br. 17-56. We find that Appellants have demonstrated that the Provisional Application provides support for the claimed invention (*e.g.*, App. Br. 33-34). Therefore, the effective filing date of the application is August 4, 2000; thus Quak does not qualify as prior art under 35 U.S.C. §102(e). *See* FF 2-3.

Since Quak does not qualify as prior art, we will not sustain the Examiner's obviousness rejections based upon Alex and Quak, as well as Alex, Quak, and Emo. Neither Alex nor Emo addresses the deficiencies of the obviousness rejections caused by the disqualification of the Quak reference as prior art.

## CONCLUSIONS

1. Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the

enablement requirement, because the Provisional Application failed to describe or mention limitations that are present in the claims.

2. Quak does not qualify as prior art under 35 U.S.C. § 102(e).
3. Quak does not qualify as prior art, and therefore Appellants have shown that the Examiner erred in finding that the combination of Alex and Quak discloses a method for providing an early warning of thermal decay on a magnetic disk wherein a test pattern has a higher data density than the user data on the disk.
4. Quak does not qualify as prior art, and therefore Appellants have shown that the Examiner erred in finding that the combination of Alex, Quak, and Emo discloses a track located in a first zone and a frequency for the user data located in a second zone of a magnetic disk.

#### ORDER

We will not sustain the Examiner's decision rejecting claims 1-100.

#### REVERSED

babc

SEAGATE TECHNOLOGY LLC  
C/O WESTMAN, CHAMPLIN & KELLY, P.A.  
SUITE 1400  
900 SECOND AVENUE SOUTH  
MINNEAPOLIS, MN 55402-3244